

REMARKS

Claims 68-84 are now in the case. Support for new claims 82-84 can be found on page 14, lines 8-20, of the subject application.

Claims 68-72 and 74-81 stand rejected under 35 U.S.C. § 103(a) based on Matsuzaki et al. in view of the design patent to d'Huart, both of record. This rejection is respectfully traversed both as to these claims and to the extent it is relevant to new claims 82-84.

The shortcomings of Matsuzaki et al. have been previously made and are incorporated by reference herein. Applicants, however, wish to comment upon an admission made by the Examiner in item 8-3 on page 10 of the Office Action. The Examiner states that Matsuzaki et al. discloses in column 7, lines 4-6, the following: "1-10 denotes a combination design unit which designs the product based on the specification required by a customer." Based on this statement, it is clear the customer does not select the desired watch constituent parts of the watch outward design in Matsuzaki et al.

The system disclosed in Matsuzaki et al. produces a design product such as a toy plane (Figs. 9 and 10) in accordance with the customer's specification entered by the product specification defining system shown in Fig. 6 (and discussed in column 9, line 10, to column 10, line 47). As described, the customer does not select the parts of the desired products, but inputs the specification for the desired products.

Column 7, lines 4-15 of Matsuzaki et al. states that the resulting design is not a rigid new design for the required specification, but a combination design having allowable parts to be used and an allowable working range. The customer is not

identified as either the means that selects the parts of the desired product or the one that combines the parts into the desired product. Instead, the combination design unit 1-10 itself is said to design the product based on the specification required by the customer. The term “the specification” is not defined in this patent as the selection of parts.

Accordingly, it is submitted that Matsuzaki et al. does not disclose or suggest the step of selecting desired watch constituent parts from the watch constituent parts in accordance with the input from the consumer terminal by using the design software, as recited in claim 68.

One of the features of the original watch outward design creating method is for the consumer to be able to add its originally created parts to the original watch. In Matsuzaki et al., the consumer does not create original parts but instead inputs the specification to the product design creating means 10. Thus, Matsuzaki et al. does not disclose or suggest the step for creating original parts digital information by using the design software, as also recited in claim 68.

Because Matsuzaki et al. does not disclose or suggest the step for creating original parts digital information by using design software, Matsuzaki et al. does not disclose or suggest the step for creating in the consumer terminal an original watch outward design by using the design software to combine the watch parts using digital information related to the desired watch constituent parts and the original parts digital information, as further recited in claim 68.

The d'Huart patent is a design patent which discloses one non-divisible watch design. It does not correct the deficiencies of Matsuzaki et al., as discussed above.

d'Huart does not disclose or suggest the watch parts digital information of claim 68. It does not disclose or suggest the step for creating original parts digital information nor the step for creating original watch outward design information as recited in claim 68. The Examiner proposes that the d'Huart design patent, because it shows the outward design of a watch, makes inherent "the necessary watch parts digital information indicating watch constituent parts and the original watch design information for creating watch design." This proposal has no basis. The d'Huart design patent is unrelated to the field of creating an original watch outward design using a computer, and any assertion of inherency is speculative.

The claims dependent on claim 68 are patentable over Matsuzaki et al. and d'Huart based not only on their dependency from claim 68 but also for any novel or unobvious steps. By way of example only, claim 70 recites confirming color tone according to original watch outward design informalities; claim 75 recites selecting location, number, length, font, and color of a dial-plate message on the screen of the consumer terminal by using the design software; claim 76 recites displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software; claim 78 recites inputting in the consumer terminal message information independently created by the consumer; claim 79 recites inputting in the consumer terminal watch design information independently created by the consumer; and new claims 82-84 recite three examples of original parts digital information.

The rejection of claims 71-74 and 76 by the addition of Maxey et al., of record, is again respectfully traversed for the reasons advanced in the Submission filed with the RCE on March 8, 2004. The Examiner is again requested to identify by page(s) and

line(s) in the Maxey et al. CAD guide the disclosure of the steps claimed in these five rejected claims.

None of these three disparate references teach an original watch outward design creating method in which it is the consumer that selects the desired watch constituent parts through use of design software to create original watch outward design information. There is no motivation in any of these references to combine them in the manner proposed by the Examiner, and no prima facie case of obviousness can be made. The Examiner attempts to solve the quandary of lack of motivation by speculating in item 8-4 on page 10 that motivation is found in the knowledge generally available to one of ordinary skill in the art of watch making. If this knowledge is so readily available, certainly the Examiner ought to have been able to cite one publication that discloses this knowledge and establishes the motivation needed to modify the Matsuzaki et al. patent to arrive at the claimed processes. The very case of In re Jones cited by the Examiner on page 10 of the Office Action is in point here. The Federal Circuit found no motivation in the prior art to make the modifications needed to arrive at the claimed invention and thus no prima facie case of obviousness. More importantly, the Federal Circuit took issue with the PTO for speculating that motivation existed:

Conspicuously missing from the record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy) ethanol salt.

In re Jones, 958 F.2d 347, 351 (Fed. Cir. 1992).

The two cases cited by the Examiner in item 8-5 on page 10 of the Office Action to support a prohibition on attacking references individually do not appear to be in point here. An applicant is always permitted to discuss an individual reference to show, as examples, lack of motivation, a missing teaching or suggestion, hindsight reconstruction, lack of knowledge in the prior art, and non-relevance to distinguish over the cited references or to show how the claims avoid the references. The Examiner is respectfully requested to reconsider his position as to this point.

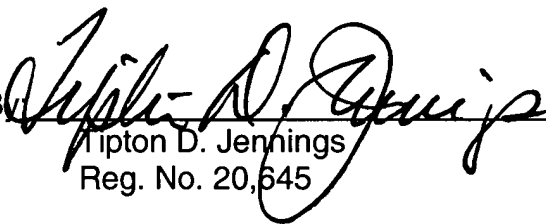
Reconsideration and allowance of claims 68-84 are earnestly solicited.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 6, 2004

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